



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,510	10/16/2003	Scott A. Jones	03-622-F	6721

20306 7590 06/21/2006

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
----------	--------------

2627

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/687,510		JONES ET AL.	
	Examiner		Art Unit	
	TAN X. DINH		2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 2627

- 1) This application is a REISSUE Application of US 6,304,523 filed 1/05/1999.
- 2) The preliminary amendment filed 10/16/2003 is acknowledged. New claims 8-11 have been added.
- 3) This reissue application has been filed without submitting the list of references in original US patent 6,304,523. Form PTO-1449 which includes all the references in the original patent is required in next communication.
- 4) Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases " the recording " or " said recording " (claims 8-11) are unclear, confusing and cannot be understood. The phrases " the recording " or " said recording " in some part of the claims has meaning as recording process and in the other part has meaning as recording medium. The claims must particularly point out and distinctly the meaning of these phrases by specifying which part of

Art Unit: 2627

the claim "recording " means the recording process and which part of the claim "recording " means recording medium.

5) The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The Oath or Declaration must properly identify at least one 35 U.S.C. 251 error being replied upon as a basis for the reissue and that it is indeed an appropriate error for reissue (37 CFR 1.75(a)(1)). Specific changes or amendment to the claims must be identified. If *new claims are presented their differences from the original claims must be point out*. See MPEP 1414. In this case, the differences between the original claims 1-7 and new claims 8-11 are not specific point out.

The reissue Oath or Declaration filed with this application is further defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

6) The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2627

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7) Claim 8-11 are rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original fails to specifically show that the display is mounted on a first surface of the enclosure. The fact is that the enclosure does not define the surfaces (first, second, third, etc.,), therefore, to claim the display mounted on a first surface of the enclosure would inherently mean the enclosure having multiple surfaces. This feature is considered to be new matter.

8) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

Art Unit: 2627

reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9) Claims 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 09/976,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of co-pending Application No. 09/976,038 discloses all the features as claimed in 8 of this instant application, except an enclosure. However, this difference is not a patentable weight since the enclosure (or housing) is inherent in every data recording device for covering the components of the device. Whether the enclosure (housing) is positively recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection

Art Unit: 2627

between combination and sub-combination of elements used in overall system and that would not making them patentable distinction.

Claims 9-11 recite Ethernet interface, TCP/IP protocol and LAN which are old and widely used in the network for communicating between local work station to a remove database.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

11) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12) Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by WEHMEYER (6,034,925).

WEHMEYER discloses an apparatus for playback of recordings and communication with a remote database to obtain information related

Art Unit: 2627

to the recordings as claimed in claim 8, comprising:

an enclosure (Fig.1, the jukebox 100 includes controller (computer) 125, local database (hard-disk, CD-R, etc.,) 135, media reader 115, communication link 145 and I/O 180);

a recorded signal output device disposed in enclosures to reproduce a recorded signal from a recording (Fig.1, Media Reader 115);

a controller disposed in enclosure and coupled to recorded signal output device to control the apparatus (Fig.1, controller 125);

a display mounted at a first surface of enclosure and coupled to controllers to display information related to the recording (Fig.1, display 184);

a memory disposed in enclosure and coupled to controller to store the information related to the recording, for output to the display in response to output of the recorded signal by the recorded signal output device (Fig.1, local database/memory 135);

a communication devices disposed in enclosure and coupled to controller to obtain the information related to recording by establishing communication with the remote database via the Internet, querying the remote database based on information in the recorded signal reproduced from the recording and supplying the information related to the recording from the remote database to

Art Unit: 2627

memory (Fig.1, communication link 145 links jukebox 100 to remote database 155 for obtaining information related to the recording (song title, number of tracks, length of tracks, track/song names, etc.,. See column 3, line 53 to column 3, line 51).

13) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14) Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WEHMEYER (6,034,925).

WEHMEYER discloses all the subject matter as claimed in claims 9-11, except to specifically show that the communication device uses Ethernet interface, TCP/IP protocol or LAN to access to Internet. However, the method of using Ethernet interface, TCP/IP protocol or LAN for accessing to Internet are old and widely used in the networking art, thus, to use Ethernet interface, TCP/IP protocol or LAN to access to Internet as claimed is deemed obvious to someone within the level of skill in the art.

15) Claim 8 is further rejected under 35 U.S.C. 102(e) as being anticipated by YANKOWSKI (5,751,672).

YANKOWSKI discloses an apparatus for playback of recordings and communication with a remote database to obtain information related to the recordings as claimed in claim 8, comprising:

an enclosure (Fig.2, the CD changer system includes controller (computer) 32, local database (hard-disk, CD-R, etc.,) 36, CD changer 20, communication link 40);

a recorded signal output device disposed in enclosures to reproduce a recorded signal from a recording (Fig.2, CD changer 20, figure 3 shows the detail of CD changer 20);

a controller disposed in enclosure and coupled to recorded signal output device to control the apparatus (figure 2, computer 325);

a display mounted at a first surface of enclosure and coupled to controllers to display information related to the recording (Fig.3, display 82);

a memory disposed in enclosure and coupled to controller to store the information related to the recording, for output to the display in response to output of the recorded signal by the recorded signal output device (Fig.2, computer 32 includes disk drive 36; Fig.3, memory 72);

Art Unit: 2627

a communication devices disposed in enclosure and coupled to controller to obtain the information related to recording by establishing communication with the remote database via the Internet, querying the remote database based on information in the recorded signal reproduced from the recording and supplying the information related to the recording from the remote database to memory (Fig.2, modem 40, phone line 44, remote database 50. See also column 7, line 3 to column 8, line 65).

16) Claims 9-11 are further rejected under 35 U.S.C. 103(a) as being unpatentable over YANKOWSKI (5,751,672).

Claims 9-11 are reject as being unpatentable over YANKOWSKI with the same reasons set forth in paragraph (14) above.

17) Claims 1-7 are allowed.

18) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the

Art Unit: 2627

objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

19) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:00PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER
May 25, 2006